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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1957

No. ~~1029~~ 70

THOMAS E. BRYAN,
Petitioner,

vs.

SID W. RICHARDSON, INC.,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit

RESPONDENT'S BRIEF IN OPPOSITION

GILLIS A. JOHNSON
1590 Sinclair Building
Fort Worth 2, Texas
Counsel for Respondent

Charles L. Stephens
Of Counsel

June 25, 1958

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Opinions Below

The opinion of the District Court (R. 835-46) is reported at 114 F. Supp. 916. The opinion of the United States Court of Appeals for the 5th Circuit is reported at 254 F. 2d 191.

Jurisdiction

The jurisdictional requisites are adequately set forth in the petition.

Questions Presented

Question 1: Is it necessary in this case to even resort to the third paragraph of Section 112 of the Patent Act as added in 1952, or to try to construe such amendment in the light of the case law govern-

ing claims in combination patents both before and since such amendment which have often sustained the validity of a combination patent in which it appeared that novelty lay in the combination itself, although "means" language had been employed concerning one of the old elements in such novel combination?

This question should be answered in the *negative* under *Faulkner v. Gibbs* and other cases.

Question 2: In a combination patent, the validity of which has been sustained by both courts below because of novelty residing in the combination itself, as well as novelty of one of the elements in such combination (to wit, the stationary element), is it permissible under Section 112 of the Patent Act as amended in 1952 to employ "means" language with reference to the performance of a specified function in the novel combination of an old and well understood device (to wit, the movable element), with which the novel element is designed to co-act and cooperate to make a new and complete working **machine**, producing a new and useful result never before possible?

This question should be answered in the *affirmative* under the plain language added in 1952.

Question 3: When, on the basis of disputed testimony of patent experts and after lengthy demonstrations, the lower courts have found the precise point of novelty of a combination patent to reside in the *combination* itself, which incorporates a *new* sta-

[1] 28th Finding of Fact, R. 862.

tionary element, which in co-action with *old* and well known movable devices makes a complete operating machine, will this Court undertake to review the factual findings of both courts below in the complete absence of "a very obvious and exceptional showing of error," and especially in this case in which the petitioner has failed both here and in each of the lower courts to anywhere directly challenge the findings of fact made against him as being without support in the evidence, and has further failed to demonstrate that the courts below have clearly misapprehended the effect of the evidence?

The answer to this question should be in the *negative*, and petitioner's effort to now confine and fasten our claimed novelty to the old movable element must be rejected.

Statutes Involved

The pertinent provisions of the Patent Act of 1952, 35 U. S. Code, Section 112, are set forth in the petition at p. 4.

Statement

1. *Nature of the case:*

This is an ordinary patent suit brought by respondent against petitioner for infringement of Claims 1, 4 and 6 of its combination Patent 162 and Claims 1 through 4 of its improvement Patent 903. The trial court, after a full hearing and based upon conflicting testimony of expert witnesses and demonstrations, and

[2]District Court's opinion, 144 F. Supp. at 920, par. 4.

based upon comprehensive findings of fact and conclusions of law (R. 846-75), held the patents valid and petitioner's infringement willful and deliberate[3] and entered a judgment (R. 875-8) permanently enjoining petitioner from making, using or selling his accused device and any other apparatus embodying the invention protected by the claims in issue of the two patents. This judgment was affirmed on appeal by the 5th Circuit.

Since no other suit has been brought for infringement of these patents, this case presents no conflict of decisions between courts of appeals with respect thereto. The decision below, of which petitioner asks review in part only, is based upon its own facts and affects no one but the litigants. The petition only seeks review of that portion of the judgment validating respondent's combination Patent 162 (petition, p. 5), and even its attack on that patent is now limited to the charge of employing "means" language with respect to an old and well-known element in claimed contravention of what is urged as being the "doctrine" announced by this Court in *Wabash*[4] and *Halliburton*[5].

Such attack is based on a pretense diametrically opposed to findings of both courts below, arrived

[3] 144 F. Supp. 918, as to which he stated in footnote 4 at that juncture of his opinion: "I hesitate to find that he (petitioner) deliberately falsified, but his testimony is of such a nature, so unsatisfactory, so many times in the face of the clear facts and his attempted purloining of plaintiff's invention so deliberate and brazen, that I find against him on all disputed issues," and of which the 5th Circuit took note in its opinion (254 F 2d 193, fn. 6).

[4] *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364.

[5] *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1

at after studied consideration of the disputed testimony on the point resolving against petitioner his express contention there made that the novelty of the invention covered by Claims 1, 4 and 6 of 162 lay only in the new use of old and well-known devices to be employed for laterally shifting a gas-lift valve into the side-pocket seat, located hundreds of thousands of feet below the surface of the ground, while suspended from the end of a wire line (petition, p. 7). This attack involves questions of fact twice resolved against petitioner by the courts below and should not be further reviewed by this Court.

2. *Counter-Statement of the facts:*

Petitioner's "Concise Statement of the Case" is argumentative and ignores express findings of fact to the contrary at no point in this litigation challenged by petitioner, and his statement is further incomplete and gives an inaccurate impression of the facts and of the only issue that can now be involved here. A clearer and more accurate statement of the case follows:

The District Court, After Hearing Conflicting Testimony on the Issue of Novelty and With Respect to Just Wherein the Novelty of Combination Patent 162 Lay, Made Findings of Fact Which Settled the Issue

Respondent's combination Patent 162 here involved relates to the production of oil by the gas-lift method.* It did not deal with a gas flow-control valve itself,

*Described in footnote 2 of the 5th Circuit's opinion, 254 F. 2d at 192.

but instead disclosed to the oil and gas industry for the first time[7] a receptacle or "mandrel" permitting as employed in such novel combination selective insertion and removal of such a valve or valves underground while at the same time leaving the tubing bore fully open so as to permit numerous desirable well operations below the point of such installation or installations. (Usually a number of such valves will be installed in series in the system.)

The claims in issue of combination Patent 162 constituted invention of "pioneer or near-pioneer status," "fulfilled a pressing need in the industry never before solved by common ingenuity and which had eluded the search of all others skilled in the art, including defendant," and were accordingly found to be entitled to "liberal interpretation and broad equivalents consistent with the scope of the novel concept and the importance of the contribution to the industry."[8]

The long existing problem[9] was solved by respondent's 162 disclosing "the *novel concept of a combination* of co-acting elements of a side-pocket mandrel and shifting tool which left open the tubing bore and yet had full selective retrievability of flow-control units. Under prior gas-lift apparatus this had not been possible before."[10]

In order to further show that the questions said by the petition (p. 3) to be here presented have been

[7]Conceded by Bryan on cross-examination (R. 521) and so found by the trial court (Memorandum Opinion, R. 835; Finding of Fact No. 10, R. 850-51.

[8]16th Finding, R. 853-54.

[9]12th Finding, R 852.

[10]10th Finding, R. 851.

finally settled below on the facts, we quote at length from the trial court's 19th Finding (R. 855-56), which is a complete answer to petitioner's contention as to where the **precise point of novelty** lay in combination Patent 162:

> "19. The new element in the novel combination was the stationary element or receiving section consisting of a side-pocket mandrel as an integral part of the tubing string . . . while the suspended movable element and parts for lateral shifting by well-known kick-overs, centralizers, whipstocks, trap doors, and by other slanted guides was in fact old in the oil well art and in the industry and only put to a new use in the novel combination . . . and *the precise point of novelty in the invention did* **not** *reside in the movable element and its parts.*"

Petitioner still argues otherwise, although all findings of the trial court stand unchallenged here.

With respect to the detail in the specifications and claims required by Section 112, the trial court further found [11] that the patent applicants had described the essence of the invention in permissible language and had given different illustrative forms of the old element — the kick-over tool, as to which petitioner seeks to limit novelty — and had:

> ". . . disclosed to anyone skilled in the art that the novel combination was fully operative and would permit the inventive co-action claimed while underground between the *novel offset mandrel* as the stationary element and many forms of the old and well known tools and sub-combina-

[11] 20th Finding, R. 856-58.

tions capable of being suspended and laterally deflected in a well . . . ."

and that:

"The 'means' language employed in Claim 1 of patent 162 with respect to the old element was only a convenient formula of the broadest equivalency of which the real invention permitted and extended as broadly as was consistent with the extent of the inventive step . . . ."

and that:

". . . the 'means' language as structurally limited to the shifting tool capable of lateral deflection with its appendages which had been taken from the prior art was not subject to the charge that it was a purely functional statement which went beyond the point of invention, and anyone skilled in the art reading such combination claims in the light of the complete disclosure could have construed such a combination and readily apprehended the nature of the invention and the limits of its scope."

Respondent's Patent 903 (R. 1039) — the validity and petitioner's infringement of which are no longer contested by him — was granted upon an application filed as an express continuation in part of respondent's 162 as constituting an improvement of elements or subcombinations of dominant 162. While the claims in 162 were on the novel combination, the claims of 903 were either on the stationary element or mandrel per se (Claims 1 through 4, as to which respondent charged infringement by petitioner) or on a mechanical version of a kick-over tool per se thereafter in-

vented (as to which respondent did not charge infringement because not of the opinion that the kick-over apparatus in the accused device fell within their scope).

Likewise, respondent's improvement Patent 904 (R. 1225) was granted upon an application filed as a continuation in part of dominant 162. It pertained only to an improved electrical type of kick-over device. (It was not sued upon by respondent, but by counterclaim petitioner sought to put it at issue; his counterclaim was dismissed by paragraph 10 of the trial court's judgment, R. 874).

It is thus not true, as stated in the petition at p. 6, that upon a single simple improvement over the prior art respondent was "issued five different sets of patent claims in three patents." 903 is no longer involved in this litigation, and 904 never fairly was; reference to them in the petition only beclouds the issue.

In final rebuttal to petitioner's "Concise Statement of the Case" we quote the trial court's 22nd Finding of fact (R. 858), arrived at only after his careful consideration of the disputed testimony with respect to the state of the art existing at the time of 162's invention and his determination of what was novel and entitled to be claimed in said patent:

> "22. The claims in issue in Patent 162, when fairly read and interpreted, do not overclaim or seek to cover a mere idea or result and are not subject to the vice of employing functional language at the sole point of novelty. The claims and specifications of Patent 162 comply with the requirements of Section 112."

although we could, at the expense of lengthening this reply, quote many other findings of the trial court with respect to the prior art showing that the problem existing at the time of 162's invention was not as simple as petitioner infers in his statement of the case, and that instead its disclosure constituted a great step forward in the art.

* * *

Argument

In an effort to secure certiorari, petitioner misinterprets the holdings below and, ignoring the novelty of our stationary element, here asserts that they are in conflict with the interpretation placed by this court in *Wabash* and *Halliburton* upon the predecessor to present Section 112 of the 1952 Patent Act. The "conflict" which petitioner seeks to create is without substance. This court's holding in *Faulkner v.Gibbs**,338 U. S. 267, is a complete answer to the entire petition and requires its denial, because here, as there, the patent is also sustainable "because of the fact of combination rather than the novelty of any particular element." (*Id.* 338 U.S. 268).

This is borne out by express statement in the opinion you are asked to review:

> "The novelty, as the (trial) Court found, was the '***combination of co-acting elements . . ." 254 F.2d 194, par. 2.

Contrary to fact, the petition infers (p. 20) that the courts below sustained the validity of 162 only on the basis that its claims were saved "by virtue" of the third paragraph of Section 112, and further only because the courts below entertained the opinion that the third paragraph of Section 112, added to the previous two paragraphs contained in its predecessor, "modified or dominated" such two earlier paragraphs "to an extent that it now overrules the line of cases headed by the *General Electric Co. v. Wabash Appliance*

*In which this court, "being moved by the petition . . . that there was a conflict with *Halliburton* . . . granted certiorari" but then held Halliburton "inapposite."

Corp. case and the *Halliburton Oil Well Cementing* which formerly violated that statute."

Petitioner's inference is unwarranted, however, because it is clear from the opinions of both courts below that their judgments were not based solely upon §112 but were instead also grounded upon the long line of cases beginning with *Paper Bag*[12] and culminating with this court's latest pronouncement on the point in *Faulkner v. Gibbs.*

The trial court stated in his opinion:

> "Usage of what otherwise might seem to be functional language in combination patents had been recognized as proper in many cases (citing in a footnote Paper Bag, Faulkner v. Gibbs, Davis Sewing Machine Co. v. New Departure and other cases) before the amendment of 1952 . . . . the Court, before the amendment, again recognized in Faulkner v. Gibbs . . . propriety of the use of functional language in combination patents and patentability 'because of the fact of combination rather than the novelty of any particular element . . . .' To my mind there is no conflict between Halliburton and Faulkner v. Gibbs as to the *principles* announced." Id., 144 F. Supp. 920-921 (emphasis by the court).

The Fifth Circuit opinion considered that §112 "was meant . . . to restore vitality to the principles *before* and since pronounced (citing Faulkner v. Gibbs, Davis Sewing Machine, Paper Bag among other authorities)." *Id.*, 254 F. 2d 194, par. 3.

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[12]*Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405.

I

The Decision Below is Clearly Correct

In his attack upon 162 it is petitioner's strategem to avoid its complete disclosure and, although there was incorporated in such combination as a new element the stationary side-pocket mandrel, to pretend that the novelty and invention lay in the movable element. But the findings of fact made below, unchallenged here, contradict him, as already pointed out in our counter-statement. Even if such findings were here challenged and reviewed by this court it would be found that they have "ample" support in the evidence:

> "Q. ***what in your opinion is the exact point of novelty in the 162 Combination Patent?
>
> "A. *The novelty is in the combination.* It is a combination of elements and some new and some old that produce new and improved results." (Lane, R. 794).

In an attempt to show that the claims "are fatally indefinite and functional" the petition (p. 10-11) seeks to segregate the elements thereof with counsel's "commentary" arguing that none of the elements so segregated show novelty and that only the "use of a shifting tool . . . breathes life into the claim and consequently therein is the exact point of novelty . . . (and that) to argue otherwise appears without basis."

It is not a matter of "*arguing*" otherwise but instead of whether the trial court's *factual* finding otherwise[13] is correct—a matter not subject to review here under the questions assigned by the petition.

[13]". . . the precise point of novelty did *not* reside in the movable element and its parts." (19th Finding, R. 855).

Claims in 162 are Valid Even Without the Aid of the new Language in Section 112

Long prior to the 1952 statutory amendment expressly authorizing the employment of "means" language, and at least since the decision in "Paper Bag" which has never been overruled[14], the employment of means language in a combination claim was permitted. Such is also the essential current holding by the Supreme Court in *Faulkner v. Gibbs*, 338 U. S. 267, where this court sustained a combination patent as against the attack that it "merely represented an attempt to patent a function or result"[15] "because of the fact of combination rather than the novelty of any particular element."[16]

In conceding (petition, p. 22) that such cases permit the use of "means" language where used "with reference to the connecting parts which permit the salient novelty of the invention to accomplish its function," petitioner effectually admits himself out of court, because, as found by the courts below, that was the very use to which the "means" language was put in 162. As pointed out in quoted language from the opinion in the *Davis Sewing Machine* case, which appears at p. 21 of the petition, a claim is not functional and invalid "merely because one of its specified elements is 'means,' " and it is permissible to use means language "with reference to elements or parts of the combination *already well known* and designed only to co-operate

[14] But instead was explained with approval by this court in Halliburton: "In that case, however, the claims structurally described the physical and operating relationship of all the crucial parts of the novel combination." 329 U.S. @ 13-14.

[15] See appellate opinion, 170 F. 2d 34, 35.

[16] Id., 338 U.S. @ 268.

with the new element in order to make a completely operative unit."

What better description could fit the employment of the "means" language here? As we have already seen, the trial court expressly found that not only was the combination novel but also that its stationary element was novel, and further that the kick-over or deflecting devices called for in "means" language were already old in the art and only put to a new use in the combination patent to cooperate with the new mandrel "to make a completely operative unit."

In almost the same language employed in the *Davis Sewing Machine* case, the trial court in his opinion found that the "means" language employed in 162 was:

> ". . . used twice in Claim 1 in connection with with movable elements or parts already well known and designed to co-operate with the new element in order to make a complete operating machine."[17]

Even if one accepts, arguendo, petitioner's contention that Section 112 merely codified "the previous case law" and that "the rule is best stated in Davis Sewing Machine Company" (petition, p. 21), it is readily apparent that the employment of means language in such Claim 1 of 162 complied with the rule stated in that case. When it is realized that the true point of novelty as factually ascertained by the trial court resided in the combination of the novel stationary element, designed to cooperate with old and well-known kick-over devices to make a complete operating machine, it be-

[17]44 F. Supp. 920, par. 4.

comes clear that the claim was properly and validly drawn under the rule of the *Davis Sewing Machine*, *Paper Bag*, and *Faulkner v. Gibbs* cases.

Before one can reach for determination petitioner's contention that the *Wabash* and *Halliburton* doctrines control, there must first be overturned this finding of the trial court with respect to where the novelty lay in 162, and this the court cannot do because not only is there complete absence "of a very obvious and exceptional showing of error" with respect to such finding, but also because petitioner has not even challenged it.

As this Court succinctly stated in its first *Graver Tank* opinion (331 U.S. 271 at 275):

> "A court of law, such as this Court is, rather than a court for correction of errors in fact-finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing of error . . ."

It is therefore obvious that for this Court to review the judgments below upholding the validity of 162 would of necessity require a redetermination of a factual issue through examination, contrary to the rule oftentimes announced by this court,[18] of an extensive record resulting from a week-long trial containing disputed testimony of patent experts on the point twice resolved in respondent's favor by the courts below.

[18] *Williams Mfg. v. United Shoe Machinery Co.*, 316 U.S. 364; the Second *Graver Tank* case, 336 U.S. 271; and *Faulkner v. Gibbs*, 338 U.S. 267.

II

There is No Conflict of Decision

Petitioner seeks to invoke your jurisdiction upon a claimed conflict between the decision below and "applicable decisions of this Court and Courts of Appeals of other Circuits"[19] and further because it is said that the Fifth Circuit "has erroneously construed and applied" 35 U.S.C. §112.

This is the only time that respondent's 162 patent has been before a court for adjudication, and so there can exist no conflict between the decision below and any other with respect to it. We shall demonstrate that such decision below is not in conflict in principle with this court's decision in *Wabash* or *Halliburton*, but instead in harmony with their pronouncements, and that the same is true of the decision in *Warren v. Nashua*:

1. *General Electric v. Wabash*, 304 U.S. 364.

In this case the claims were invalidated because the inventor "did not adequately set out 'what he claims to be new' " in the very limited field in which he was working (304 U.S. @ 369). The crowded art upon which the inventor had sought to improve involved incandescent lamps, and the problem he sought to solve was the prevention from sagging of the tungsten filament in such lamps. He sought to accomplish this by bringing into intimate association with the tungsten during its heat process of being made into a filament an alkaline silicate which would control the grain

[19]He only cites one opinion by the First Circuit: *Warren v. Nashua*, 205 F. 2d 602.

growth of the tungsten. In speaking on the definiteness required in a patent pertaining to such a crowded art, this court there said:

> "Patentees may reasonably anticipate that claimed inventions, improvements and discoveries, turning on points so refined as the granular structure of products require precise descriptions of the new characteristic for which protection is sought. In a limited field the variant must be clearly defined. This was one in a series of patents." *Id.*, 304 U.S. 369.

But instead of giving such a clear definition of his new variant in his method patent, the inventor instead merely defined it in terms of the solution of the problem (e.g., a "frost-less refrigerator coil," "perpetual motion", etc.). His claim 25, regarded as typical, read in part:

> "25. A filament . . . composed substantially of tungsten and made up mainly of a number of comparatively large grains *of such size and contour as to prevent substantial sagging . . .*"

His only novelty was thus expressed, in the language italicized, in terms of result, of which clause this court there said:

> "The clause is inadequate as a description of the structurel characteristics of the grains." *Id.* p. 370.

and that the claim thus fell

> "within the condemnation of the doctrine that a patentee may not broaden his product claims

by describing the product in terms of function." *Id.* p. 371.

But this court did not there condemn all use of "functional" or "means" language; it only did so with respect to use of same "at the exact point of novelty (*Id.*, p. 371), saying:

> "A limited use of terms of effect or result, which accurately define the essential qualities of a product to one skilled in the art, may in some instances be permissible and even desirable, but a characteristic essential to novelty may not be distinguished from the old art solely by its tendency to remedy the problems in the art met by the patent." *Id.*, p. 371-72.

As we have seen, the trial court expressly found that the means language in respondent's 162 patent was not employed at the precise point of novelty but was instead used only

> ". . . with respect to the old element . . . and anyone skilled in the art reading such combination claims in the light of the complete disclosure could have constructed such a combination and readily apprehended the nature of the invention and the limits of its scope." (20th Finding, R. 857-58).

There could only be conflict between the decision below and the holding in *Wabash* if petitioner's postulate with respect to where the novelty in 162 lay were correct; as the trial court found against him on this factual issue, and such finding is not challenged here, the *Wabash* rule is inapposite.

2. *Halliburton v. Walker*, 329 U.S. 1.

An examination of the history of the litigation in Halliburton clearly discloses that its holding is also "inapposite" to the combination patent here involved, just as it was held inapposite to the combination patent involved in *Faulkner v. Gibbs*, 338 U.S. 267. Further distinguishing our case is the fact that one of the elements in 162 was itself *new*.

The trial court had found that Halliburton was infringing Claims 1, 13, 14, 15 and 17 of Walker's 519 Patent[20]. In its opinion this Honorable Court expressly recognized that other claims of that patent (not claimed to be infringed), e.g., Claims 2 and 3, did sufficiently describe the old element Walker had added to an old combination as to show "its working arrangement in the alleged new combination, and the manner of its connection with the other parts"[21], but this Court there reversed the holdings below because;

> "No one of the claims on which this judgment rests has even suggested the physical structure of the acoustical resonator. No one of these claims describes the physical relation of the Walker addition to the old Lehr & Wyatt machine. No one of these claims describes the manner in which the Walker addition will operate together with the old Lehr & Wyatt machine so as to make the 'new' unitary apparatus perform its designed function. Thus, the claims failed adequately to depict the structure, mode, and operation of the parts in combination."

[20]9th Circuit opinion, 146 F. 2d 817, 819, column 2.
[21]328 U.S. at p. 8.

The patent in *Walker* involved a combination of elements *all* of which were old (not true of 162, its stationary element, as found below, being new), because all that Walker had done was to add to a pre-existing combination an already-old device:

> "Walker's contribution which he claims to be invention was in effect to add to Lehr and Wyatt's apparatus a well-known device . . . The device added was a mechanical acoustical resonator." *Id.*, 329 U.S. pp. 6-7.

The means language he used was employed with respect to just what he had added, and, as it was only thus defined in terms of result, he clearly failed to comply with the rule of *Wabash*.

Recognition was taken[22] of the fact that the Court of Civil Appeals' opinion had stated "that the trial court had *found* 'that the only part of this patent constituting invention over the prior art is the "tuned acoustical means which performs the functions of a sound filter."' " The findings of the trial court there were thus in support of — instead of diametrically opposed to, as here — petitioner Halliburton's contention that "means" language had been employed to define the only novelty in the invention.

Without a similar finding here to the effect that the movable element or sub-combination called for in 162 constituted its only novelty, Halliburton is inapposite. Not only is there an absence of such finding in the record before you, but, as we have seen, the trial court find exactly the opposite:

"... the precise point of novelty in the inven-

[22] 329 U.S. @7.

tion did not reside in the movable element and its parts." (19th finding, R. 855).

In rejecting petitioner's very same contention below, the Fifth Circuit, after expressly noting that petitioner's counsel was seeking to confine the novelty of 162 "to the manner in which the valve is moved laterally and is seated or unseated", and that Bryan's attack on 162 was that its principal claim was "so broadly stated as to define the invention solely by statements of function and result," said:

> "We do not agree.
>
> "The novelty was not, as Bryan claims, the mechanism by which the tool could be laterally shifted to insert or retrieve the valve. The novelty, as the Court found, was the '***combination of co-acting elements of a side-pocket mandrel and shifting tool which left open the tubing bore and yet had full selective retrievability of flow-control units. Under prior gas-lift apparatus this had not been possible before.'." (254 F. 2d 193-4).

As further showing that the courts below did not miscomprehend the state of the law, as claimed by petitioner, we quote further from their opinions:

> "This contention as to invalidity was the principal point upon which the court expressed a desire for light at the conclusion of the evidence, as quoted at the outset of this memorandum. There can be no quarrel with the *principles* stated in the cases cited by defendant if they are applicable to the challenged claims." 144 F.Supp. 920.
>
> * * *
>
> "But where the novelty of the combination —

here the 'stationary element or receiving section consisting of a side-pocket mandrel as an integral part of the tubing string * * * capable of selectively receiving, seating and disgorging a flow-control unit * * lowered from the surface * * *' is adequately disclosed with definable limitations, other and well-known elements need not be described in structural detail." (254 F. 2d 194, par. 3).

3. *Warren v. Nashua*, 205 F. 2d 602

Unless the judgment below is in conflict with *Wabash* and *Halliburton*, it follows that it cannot be in conflict with *Nashua*, because all the First Circuit did there was to reannounce their rule and then hold that the inventor had sufficiently complied with it.

No matter how petitioner may attempt to twist the lucid holdings below, any fair appraisal of them exhibits that in neither instance was it held that Sec. 112 overrode *Wabash* and *Halliburton* by approving employment of "means" language to claim an invention only in terms of its result or a solution of a problem.

(We omit discussion of petitioner's other case with which the judgment below is said to be in conflict, *Application of Arbeit*, 206 F. 2d 947, because the Court of Customs and Patent Appeals, after belaboring the point, finally concluded:

"It is unnecessary for us to attempt a complete construction of Section 112, supra, at this time. It is sufficient to say that, in our opinion, it has no application to the facts of this case." *Id.*, p. 958.)

III.

The Petition Presents No Important Question of Federal Law

The holding below by the U. S. Court of Appeals for the 5th Circuit has no national significance, and petitioner's assertion (p. 7) "that issues of great moment to the public are involved" is but sham based on misinterpretation of such opinion and continued ignoring of what the Record shows with respect to the facts as found by the trial court.

Contrary to petitioner's contention, it is clear from the opinion of the Court of Appeals and the factual findings of the District Court that both courts were cognizant of the *Wabash* and *Halliburton* rule forbidding a patentee to claim his invention merely in terms of result by using functional language at the exact point of novelty. It is equally clear that such courts found the claims in issue here to be of the type dealt with by this Court in *Faulkner v. Gibbs* and accordingly valid under its ruling, rendering *Wabash* and *Halliburton* inapposite.

Manifestly, a review of the question of whether or not the claims in issue of respondent's Patent 162 were definite enough to comply with the case and statutory law would require this Court to first again determine the question of what was old and what was new at the time of such patent's conception and wherein its novelty lay. Such a third review of the evidence to weigh the soundness of the District Judge's findings of fact could serve no special or important purpose or serve the public interest.

The *Wabash*, *Halliburton* and *Faulkner v. Gibbs* opinions provide clear statements for the guidance of the public and the Federal Courts in their consideration of the issue, and it is not necessary to a decision here to determine the extent to which the new paragraph of Section 112 liberalized[23] the use of functional expressions in combination claims, because, as held below, the claims in issue complied with the rules existing prior to the addition of that paragraph in the 1952 Patent Act, and because such amendment can in no sense be said to have called for any stricter rule. Petitioner does not even so argue but only says that the amendment served to codify the preexisting case law on the point.

[23] "Commentary" by Examiner in Chief of the U. S. Patent Office constituting an "Introduction" to Title 35 of USCA at p. 25 of the first volume of that title.

CONCLUSION

Only private interests of private parties could be served by review of the case upon certiorari, and it is respectfully submitted that the petition should accordingly be denied.

Respectfully submitted,

Gillis A. Johnson
1500 Sinclair Building
Fort Worth 2, Texas
Counsel for Respondent

Charles L. Stephens
Of Counsel

June 25, 1958

CERTIFICATE OF SERVICE

Service of this BRIEF IN OPPOSITION to the PETITION FOR WRIT OF CERTIORARI has been made upon petitioner Thomas E. Bryan by mailing two copies thereof by regular United States mail, postage prepaid, to Oscar A. Mellin, 391 Sutter Street, San Francisco 8, California, counsel for petitioner, the same being the last address of Oscar A. Mellin known to respondent and its attorney, this 25th day of June, 1958.

Counsel for Respondent